No. 73-1092

In the Supreme Court of the United States

OCTOBER TERM, 1973

MRS. WINSTON CALDWELL, ADMINISTRATRIX, ET AL., PETITIONERS

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

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OPINION BELOW

The opinion of the Court of Claims, adopting the recommended decision of the Trial Commission (App. 1-39),[1] is reported at 481 F. 2d 898.

JURISDICTION

The judgment of the Court of Claims was entered on June 20, 1973, and a motion for rehearing was denied on October 17, 1973. The petition for a writ of certiorari was filed on January 11, 1974. The jurisdiction of this Court is invoked under 28 U.S.C. 1255.

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[1] "App." references are to Petitioners' Appendix A, which is separately bound.

QUESTION PRESENTED

Whether the Court of Claims properly denied petitioners' claim for compensation for the alleged unauthorized use of a patent on the ground that the Caldwell invention was "obvious."

STATUTE INVOLVED

35 U.S.C. 103 provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

In 1953 Winston Caldwell, deceased, filed a patent application for a "thermionic converter" which consists of two closely-spaced electrodes, an emitter and a collector, spaced approximately 0.02 inches apart, with a high vacuum between them (App. 3-5, 7). By increasing the temperature of the emitter and decreasing the temperature of the collector, electrons are emitted and electrical current is generated. With only one prior-art reference cited to the Patent Office (App. 8), Caldwell's patent application was issued in 1956. In 1958, the patent was reissued (App. 8).

Petitioners filed suit against the United States seeking to recover compensation for the alleged unauthorized use

by the government of the inventions described in Caldwell's patent. In response, the validity of the patent was challenged on the grounds that Caldwell's device was both "anticipated" under 35 U.S.C. 102 and "obvious" under 35 U.S.C. 103 from prior-art references at the time of invention. After considering these references, which had not previously been brought to the attention of the Patent Office (App. 10), the Court of Claims denied petitioners' claim for compensation. The court held that the petitioners' patent claims were invalid due to "obviousness" under 35 U.S.C. 103, and therefore, found it unnecessary to consider the other defenses raised (App. 2).

ARGUMENT

As the Court of Claims correctly held, prior-art references, which had not been considered by the Patent Office, are sufficient to override the presumption of validity accorded a previously granted patent under 35 U.S.C. 282. *Ellicott Mach. Corp.* v. *United States*, 405 F. 2d 1385 (Ct. Cl.); and *International Glass Co.* v. *United States*, 408 F. 2d 395 (Ct. Cl.) Petitioners challenge the court's finding of fact that prior-art references clearly disclose and make obvious Caldwell's alleged invention in the present case. The court's factual finding is correct and presents no issue warranting review by this Court.

1. As the court below found and petitioners concede (Pet. 4), the theory of "thermionic emission," the sole principle upon which Caldwell's invention is based, was discovered and fully disclosed by Thomas Edison in 1884. Edison found that heated metal cathodes or electrodes would emit electrons in proportion to the temperature of the electrode. In 1915, D.F. Comstock utilized this principle to develop a thermionic

converter to generate electricity. The Comstock patent involved a device which generated electrical current through the use of two electrodes, an emitter which was highly heated, and a collector cooled by a water jacket. However, in the Comstock invention the emitter and collector were not closely spaced nor directly aligned. In 1915 a device similar to Comstock's was patented by a Dr. Schlichter, except that in the Schlichter converter the electrodes were closely spaced and approximately 0.20 inches apart. Schlichter also noted that by coating the emitter with metal oxides, electron emission will be increased. Following several other relevant discoveries, it was disclosed in 1951 by Dr. Champeix that the more closely spaced the electrodes, the less the adverse effects of "space charge," a phenomenon which impedes the flow of electrodes away from the emitter, and the more efficient the device. Thus in 1953, at the time of Caldwell's alleged discovery, "the invention" had been fully disclosed by prior-art references (App. 10-12).

2. In support of the Caldwell patent in the Court of Claims, petitioners attempted to distinguish the present patent from prior-art works on the basis that no previous patent expressly disclosed electrode spacing of 0.02 inches or less as disclosed in their claim (App. 11). In light of the discoveries of both Champeix and Schlichter, which taught that electrodes should be "as close together as possible without actually touching" (App. 11-12), petitioners' argument was properly rejected below. Moreover, the court below specifically found that Caldwell's "disclosure of electrode spacing * * * came from the prior art of radio tubes" which had already disclosed electrode spacing of 0.015 inches (App. 12). The Court of Claims

thus correctly found that Caldwell's invention was "obvious," under 35 U.S.C. 103, from prior-art references and therefore, petitioners' claim for compensation was properly denied.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be denied.

Respectfully submitted.

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